

### **REMARKS/ARGUMENTS**

Preliminarily, as a matter of clarifying the record, it is not clear whether claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,462,001 ("Kenbeek '001"). Applicants note that claim 15 is not listed in the paragraph section #8 heading on page 7 of the present Official Action, however, claim 15 is listed in on page 9 (within the same section #8). Accordingly, while this is presumed to be a typographical error, Applicants submit that, unlike the Pending Claims, Kenbeek '001 is not directed towards a method of reducing wear in an automotive engine by using an automotive engine oil having the specified ester, as claimed. Rather, Kenbeek '001 suggests to the skilled artisan that a sulphur *and/or* phosphorus-containing EP/AW additive package *must be combined* with Kenbeek '001's ester when used as a gear oil additive to reduce wear of gear wheels – *i.e.*, Kenbeek '001's ester is not suitable *by itself* to reduce wear in a gear oil, much less to reduce wear in an automotive engine oil.

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 3-7, 9-11, and 21 have been amended. Claims 2, 16-18, and 20 have been cancelled. Upon entry of the above amendments, claims 3-7, 9-11, 15, 19, and 21, as amended, will be pending ("the Pending Claims"). Support for the amendments may be found throughout the specification. No new matter has been added as a consequence of these amendments.

Claims 2-7, 9, 16-18 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over, EP 0335013 ("Kenbeek '013") as evidenced by GB 1390439 ("Marchand"), and as evidenced by Croda Product Overview ("Overview"). Claims 2-5, 7, 9-10 and 16-20<sup>1</sup> stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013. Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '001, and further in view of U.S. Patent 4,479,883 ("Shaub"). Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '001, and further in view of U.S. Patent 3,202,701 ("Young"). Claims 10 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013 as evidenced by Marchand, and as evidenced by Overview, and further in view of Shaub. Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013, as evidenced by Marchand, and as evidenced by Overview, and further in view of Young.

Applicants note that as claims 2, 16-18, and 20 have been cancelled, all standing rejections cited for these claims, and those that depend thereon, are rendered moot.

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<sup>1</sup> See comments regarding claim 19 below.

Claim 15, and all claims that depend thereon (claims 3-7, 9-11, 21, as amended), stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013 as evidenced by Marchand, and as evidenced by Overview, and further in view of Shaub.

Applicants note that the Examiner has acknowledged that Kenbeek '013 does not disclose, *inter alia*, a method of reducing wear in an automotive engine by use of the ester in the claims as amended. Therefore, the Examiner relies on Shaub to assert that the methods of the Pending Claims are obvious. Applicants respectfully disagree. Specifically, the methods of Shaub are directed towards reducing friction, not reducing wear. In fact, Shaub even notes that friction reducing properties are different from antiwear properties (*compare* Shaub at col. 1, lines 33-36, *with* Shaub at col. 1, lines 45-48). Moreover, Shaub's friction reducing methods are only able to reduce friction when Shaub's particular combination of an ester of polycarboxylic acid and glycol/glycerol is combined with a separate, selected metal dithiocarbamate additive. In fact, Shaub's Example 1 illustrates that use of the ester alone or the dithiocarbamate alone is not effective.

Regarding Marchand, Applicants note that unlike the Pending Claims, which are for use in automotive engines (for example 4 stroke engines), Marchand discusses using a particular polyester specifically designed as a lubricant for a two-stroke engine. (See Marchand at page 1, lines 15-56, noting for the skilled artisan how two-stroke engines are different from four-stroke engines). Accordingly, Marchand does not teach or suggest methods of using lubricating oil compositions comprising, *inter alia*, the specified esters of the Pending Claims, as anti-wear additives in four-stroke engines.

Applicants submit that Overview fails to overcome the above-noted deficiencies of Kenbeek '013, alone or in combination with the other cited references. For at least the above-noted reasons, claim 15, and those that depend thereon, are patentable over the cited references.

With respect to claim 19, claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013, as evidenced by Marchand, and as evidenced by Overview (and as noted above). Since claim 19 is similar in relevant part to claim 15, Applicants submit that it also overcomes the cited references for at least the above-noted reasons.

Therefore, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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Date: November 18, 2009

WAI-2943763v1